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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,772	02/13/2001	Renee M. Kovales	RSW9 20000127US1	2011

7590

03/18/2004

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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

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DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,772

Applicant(s)

KOVALES ET AL.

Examiner

Joseph T Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 48, and 73_ rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant's specification and drawings do not disclose nor show a system that enables a user to establish a connection to a Uniform Resource Locator that is within a voice mail message. Page 12-13 of applicant's specification merely just states that a listener can connect to a URL but the system and method of how to enable a listener to do so is not mentioned therefore the specification does not enable one of ordinary skill in the art to make or use the invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-7, 14-20, 22-23, 28-32, 33-37, 41-47, 52-62, 68-72, and 77-81 rejected under 35 U.S.C. 102(b) as being anticipated by Holtzberg, Patent #6,625,261.**

Regarding claims 1, 33, and 57, Holtzberg teaches a method, system and computer program product for enhancing voice mail messages comprising leaving a voicemail message by a caller(col.3 lines 14-34); and providing one or more bookmarks for the voice mail message left by the caller (26 Fig.1 and col.3 lines 14-34); and creating a bookmarked message from the left voice mail message and the provided bookmarks (col.2 lines 26-33 and col.3 lines 35-44)

Regarding claims 2 and 34 Holtzberg teaches a method, system and computer program product according to claims 1 and 33 further comprising the step of creating a bookmarked message from the voice mail message and the associated bookmarks (col.2 lines 4-39).

Regarding claim 3, 35, and 58, Holtzberg teaches a method, system and computer program product according to claims 2 and 34 further comprising the step of playing the bookmarked message to a listener (col.3 lines 26-67).

Regarding claim 4, 36, and 59, Holtzberg teaches the method, system and computer program product according to claims 1, 33, and 57 wherein selected ones of the bookmarks segment the voice mail message according to one or more topics (col.2 lines 20-64 and col.3 lines 26-34).

Regarding claims 5 and 60, Holtzberg teaches the method, system and computer program product according to claims 1 and 57 wherein selected ones of the

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bookmarks are used to mark one or more segments of the voice mail message as having one or more different degrees of importance (col.1 line 62-col.2 line 64; a bookmark has a degree of importance to the user).

Regarding claims 6 and 61, **Holtzberg** teaches the method, system and computer program product according to Claims 5, 37, and 57 wherein a default degree of importance is associated with segments not otherwise marked (col.1 line 62-col.2 line 64 and col.3 lines 26-34; a standard degree of importance is associated with segments not otherwise marked).

Regarding claims 7, 37, and 62, **Holtzberg** teaches the method, system and computer program product according to claims 1, 33, and 57 wherein selected ones of the bookmarks correspond to one or more special types of information in the voice mail message (col.2 lines 20-64).

Regarding claim 14, 41, and 68, **Holtzberg** teaches a method, system and computer program product according to claims 2 or 3 or 34 or 58 further comprising the step of using the bookmarks to perform actions selectively on one or more segments of the voice mail message (col.1 line 62-col.3 line 39; action is to listen at bookmarked segment).

Regarding claim 15, 42, and 69, **Holtzberg** teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments are associated with a topic of the voice mail message(col.1 line 62-col.3 line 39; a bookmark is an important topic).

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Regarding claim 16, 43, and 70, **Holtzberg** teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments have one or more different degrees of importance(col.1 line 62-col.3 line 39).

Regarding claims 17, 47, and 72 **Holtzberg** teaches a method, system and computer program product according to claims 14, 41 and 68, wherein the selected segments are associated with one or more special types of information in the voice mail message(col.1 line 62-col.3 line 39 and col.3 lines 26-57).

Regarding claim 18, 44, and 71, **Holtzberg** teaches a method, system and computer program product according to claims 14, 41, and 68, wherein the actions comprise one or more of saving, deleting, forwarding, listening, skipping, or repeating the one or more segments, and marking a particular segment as protected or confidential prior to forwarding the marked segment to another party (col.1 line 62-col.3 line 39 and col.3 lines 26-57; repeats bookmarked segment or can forward the marked segment which is confidential).

Regarding claim 19 and 45 **Holtzberg** teaches a method, system and computer program product according to claims 18 and 44, wherein the actions further comprise marking a selected segment as protected or confidential(col.1 line 62-col.3 line 39 and col.3 lines 26-57).

Regarding claim 20 and 46 **Holtzberg** teaches a method, system and computer program product according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party (col.1 lines 20-34; the user can forward the segment which is confidential).

Regarding claim 22 **Holtzberg** teaches the method according to claim 2, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message (col.1 line 62-col.2 line 33 and col.3 lines 26-67).

Regarding claim 23 **Holtzberg** teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice mail message intermingled as the bookmarked message(col.1 line 62-col.2 line 33 and col.3 lines 26-67).

Regarding claims 28, 52, and 77 **Holtzberg** teaches the method, system and computer program product according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided (22 Fig.1 and 151 Fig.4; the user(caller) of the voice mail system is prompted for input)

Regarding claims 29, 53, and 78 **Holtzberg** teaches the method, system and computer program product according to claims 2, 34, and 58 further comprising the step of associating one or more audio cues with one or more bookmarks of the voice mail message (151 Fig.4 and 156 Fig.4).

Regarding claims 30, 54, and 79 **Holtzberg** teaches the method, system and computer program product according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or

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more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks (151 Fig.4 and 156 Fig.4).

Regarding claims 31, 55, and 80 Holtzberg teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue with its respective portion of the voice mail message (122 Fig.3 and 156 Fig.4)

Regarding claims 32, 56, and 81 Holtzberg teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(122 Fig.3 and 156 Fig.4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13, 21, 24-27, 39-40, 48-51, 64-65, and 73-76 rejected under 35

U.S.C. 103(a) as being unpatentable over Holtzberg, Patent #6,625,261.

Regarding claims 8-13, 39-40, 38-40, and 63-65 Holtzberg teaches the method, system and computer program product according to claims 7, 37, and 62.

Holtzberg is silent on if the content of the special types of information in the

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voice mail message is a callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator.

Holtzberg teaches voice mail message content that can be heard by the listener. (116 Fig.3, col.1 lines 11-20, col.2 lines 20-64, and col.3 lines 14-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to *include or speak any type of information he/she desires to leave as a voice mail message*.

One of ordinary skill in the art would have been motivated to do this as *the content of a voice mail message is not novel and is basically up to the caller's choosing as to what information he/she wishes to leave then the user after listening can associate a bookmark to it*).

Regarding claims 21, 48, and 73 Holtzberg teaches a method, system and computer program product according to claims 17,47, and 72.

Holtzberg is silent on the content of the voice mail message being a URL.

Holtzberg teaches voice mail message content that can be heard by the listener. (116 Fig.3, col.1 lines 11-20, col.2 lines 20-64, and col.3 lines 14-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to establish a connection to a URL mentally by listening to the content of the voice mail message.

One of ordinary skill in the art would have been motivated to do this as *the content of a voice mail message is not novel and is basically up to the caller's choosing as to what information he/she wishes to leave for the user to listen to.*

Regarding claims 24-27, 49-51, and 74-76 Holtzberg teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62.

Holtzberg is silent on if an announcement of the voice mail message includes a number of the bookmarked segments, a number of segments in a different degree of importance

Holtzberg teaches voice mail message content that can be heard by the listener. (116 Fig.3, col.1 lines 11-20, col.2 lines 20-64, and col.3 lines 14-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to *include or speak any type of information he/she desires to leave as a voice mail message*

One of ordinary skill in the art would have been motivated to do this as *the content of a voice mail message is not novel and is basically up to the caller's choosing as to what information he/she wishes to leave.*

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:30-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP
March 11, 2004

JTP


Creighton Smith
Primary Examiner